REMARKS

The applicant would like to thank the Examiner for the courtesy of a telephone interview conducted on June 28, 2004. During the interview, claims 1, 8, 9 and 18 were discussed, as was U.S. Patent 5,748,342 to Usami. No agreement was reached on the patentability of the claims.

Claims 4 and 5 have been cancelled without prejudice. Claims 1 and 8 have been amended. Claims 1-3 and 6-18 remain pending in the application. Reconsideration of claims 1-3 and 6-18 is respectfully requested in view of the following remarks.

Claims 1-2, 6, 8-10, 12-13 and 18 stand rejected under 35 U.S.C. § 102(b) as anticipated by Usami. Claim 3 stands rejected under 35 U.S.C. § 103(a) as obvious in view of Usami and U.S. Patent 5,844,542 to Inoue. Claims 7 and 11 stand rejected as obvious in view of Usami. Claims 14 and 15 stand rejected as obvious in view of Usami and U.S. Patent 6,004,270 to Urbano. Claims 16 and 17 stand rejected as obvious in view of Usami, Urbano and U.S. Patent Publication 2002/0028994 to Kamiyama. The applicant respectfully disagrees, and traverses these rejections for the reasons noted below.

THE USAMI REFERENCE FAILS TO DISCLOSE RECEIVING INPUT SELECTING A CONTRAST MODE FROM A PLURALITY OF CONTRAST MODES

Independent claims 1 and 8, as amended, recite methods and computer program products performing methods for selecting a rendering intent, comprising: "receiving input selecting a contrast mode from a plurality of contrast modes, wherein each contrast mode specifies a way to simultaneously compare the plurality of rendered images; [and] simultaneously previewing the plurality of rendered images according to the selected contrast mode." As recited in the claims themselves, a contrast mode is "a way to simultaneously compare the plurality of rendered images." For example, the specification discloses that the plurality of rendered images can be compared or contrasted by "simultaneously previewing the rendered images", or alternatively by "simultaneously previewing rendered image differences." [Specification, p. 6, ll. 3-7]. Indeed, claims 2 and 3 explicitly recite these two alternate ways of contrasting the rendered images. The applicant notes that it is the received contrast mode that determines whether the plurality of

rendered images are simultaneously previewed as rendered images or as rendered image differences or in some other way. For, as claims 1 and 8 recite, the method involves "receiving input selecting a contrast mode . . . [and] simultaneously previewing the plurality of rendered images according to the selected contrast mode."

The Examiner reads figure 20 of the Usami reference to disclose both "receiving input selecting a contrast mode from a plurality of contrast modes" and " simultaneously previewing the plurality of rendered images according to the selected contrast mode." The Examiner argues that the three images displayed in figure 20 of Usami are themselves contrast modes ("the three preview images are displayed for comparison, therefore are contrast modes"). However, if the received images disclosed in Usami's figure 20 are contrast modes, then the recited limitation of "previewing the rendered images according to the selected contrast mode" lacks meaning. Such an interpretation is clearly improper, as the Examiner must give meaning to each limitation recited in the claim.

If as the Examiner argues, figure 20 of Usami discloses receiving input selecting a contrast mode from a plurality of contrast modes, then it cannot also disclose simultaneously previewing a plurality of rendered images according to a selected one of the contrast modes. Conversely, if (as the Examiner also argues) figure 20 of Usami discloses previewing a plurality of rendered images according to a selected contrast mode, then it cannot also disclose receiving input selecting a contrast mode from a plurality of contrast modes. Thus, the Usami reference fails to anticipate claims 1 and 8 since it fails to disclose *either* "receiving input selecting a contrast mode from a plurality of contrast modes," *or* "simultaneously previewing the plurality of rendered images according to the selected contrast mode." Moreover, since claims 2-3 and 6-7 depend from claim 1, Usami fails to anticipate these claims as well.

Regarding claim 3, the Examiner argues that Usami discloses all the limitations of claim 3 except previewing the rendered images "as a plurality of rendered differences." To meet this latter limitation, the Examiner relies on Inoue. However, as noted above, Usami fails to disclose *either* "receiving input selecting a contrast mode from a plurality of contrast modes," *or* "simultaneously previewing the plurality of rendered images according to the selected contrast

mode" as recited in claim 1 from which claim 3 depends. Consequently, the Examiner has failed to establish a *prima facie* case of obviousness, and claim 3 is patentable over the combination of Usami and Inoue for at least this reason.

Regarding claim 7, the Examiner argues that Usami discloses all the limitations of claim 7 except previewing the rendered images by "printing them on a single sheet of paper." However, as noted above, Usami fails to disclose *either* "receiving input selecting a contrast mode from a plurality of contrast modes," *or* "simultaneously previewing the plurality of rendered images according to the selected contrast mode" as recited in claim 1 from which claim 7 depends. Consequently, the Examiner has failed to establish a *prima facie* case that claim 7 is obviousness in view of Usami.

THE USAMI REFERENCE FAILS TO DISCLOSE PREVIEWING A PLURALITY OF DIFFERENCE IMAGES

Independent claims 9 and 18 recite methods and computer program products performing methods for selecting a rendering intent, comprising: "simultaneously previewing a plurality of difference images, wherein each difference image is generated from one of the plurality of rendered images and a reference image." As disclosed in the specification, difference images can be generated from rendered images and a reference image in several ways, including "subtracting the color values of a reference image from the rendered image," and "computing for each pixel in the [difference] image the sum of the squares of the differences between the color values of the associated pixels in the rendered and reference images." [Specification, p. 7, l. 28 to p.8, l. 2]. Each of these methods for generating a difference image are explicitly recited in claims 14 and 15, respectively.

Because the difference images recited in claims 9 and 18 are generated from the plurality of rendered images and a reference image, they are not the same as the plurality of rendered images that are recited in claims 1 and 8. Nonetheless, the Examiner reads figure 20 of Usami to disclose simultaneously previewing a plurality of difference images. The applicant notes that to reject claims 1 and 8, the Examiner read figure 20 of Usami to disclose "previewing a plurality of rendered images." Now, to reject claims 9 and 18, the Examiner reads figure 20 of Usami to

disclose "previewing a plurality of difference images, wherein each difference image has been generated from one of the rendered images and a reference image." Clearly, Usami's figure 20 does not disclose both "previewing a plurality of rendered images," and "previewing a plurality of difference images." If, as applicant understands the reference, Usami discloses "previewing a plurality of rendered images," then it fails to disclose "previewing a plurality of difference images," and fails to anticipate claims 9 and 18 for at least this reason. Moreover, since claims 10-17 depend from claim 9, Usami fails to anticipate these claims as well for the same reason.

Regarding claim 11, the Examiner argues that Usami discloses all the limitations of claim 11 except previewing the plurality of rendered images by "printing them on a single sheet of paper." However, as noted above, Usami fails to disclose "previewing a plurality of difference images" as recited in claim 9 from which claim 11 depends. Consequently, the Examiner has failed to establish a *prima facie* case that claim 11 is obviousness in view of Usami.

THERE IS NO MOTIVATION TO COMBINE THE USAMI AND URBANO REFERENCES

Regarding claims 14 and 15, the Examiner argues that Usami discloses all the limitations of claims 14 and 15, except generating a difference image by subtracting a reference image from a rendered image and by calculating the least squares difference between a rendered image and a reference image as recited in claims 14 and 15, respectively. The applicant notes that while the Examiner rejected claim 9 as fully anticipated by Usami, in rejecting claims 14 and 15 the Examiner appears to admit that Usami fails to disclose generating a difference image. To supply this missing limitation in claims 14 and 15, the Examiner relies on the Urbano reference.

The Usami reference discloses "an image forming apparatus which allows a user to preview an image . . . before it is formed." [Usami at col. 1, ll. 5-9]. In particular, the Usami patent discloses a preview function that "simultaneously output[s] images . . . obtained by performing different color space processes for the same input image data." [Id. at col. 1, ll. 55-60]. The Urbano patent discloses a "difference image processing scheme ... for imaging anatomic structures or vessels which have periodic physiological motion that define physiological cycles." [Urbano at Abstract]. In the Urbano patent, a reference image is taken of

a moving object, and is subsequently compared to a sequence of real-time images that are taken at a later time until a closely aligned image is found. When a closely aligned image is found, the difference between the reference image and the closely aligned image is calculated. [Id.].

To establish a *prima facie* case of obviousness, the Examiner must find motivation to combine the teachings of Usami and Urbano. The Examiner argues that the motivation to combine these references is "to improve the alignment process." However, the Usami patent discloses previewing a plurality of output images that have been "obtained . . . for the same input image data." [Usami at col. 1, ll. 55-60]. Usami's output images are therefore always perfectly aligned, and there is no need to "improve the alignment process" as the Examiner suggests. Consequently, there is no motivation to combine the Urbano and Usami references, and the Examiner has failed to establish a *prima facie* case of obviousness. Thus, claims 14 and 15 are patentable over the combination of Usami and Urbano for at least this reason.

THE KAMIYAMA REFERENCE IS NOT PRIOR ART TO THE APPLICANT'S CLAIMS

Regarding claims 16 and 17, the Examiner argues that these claims are obvious in view of the combination of Usami and Urbano for the reasons discussed above with respect to claims 14 and 15, and in view of the Kamiyama reference. The Examiner relies on the Kamiyama reference to disclose displaying the difference images as topographical maps. However, as discussed above, because the Usami reference discloses previewing a plurality of output images that have been "obtained . . . for the same input image data," the images are always perfectly aligned, and there is no motivation to combine the Usami reference with the Urbano reference. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for at least this reason.

Moreover, the Kamiyama reference is not prior art to the applicant's claims. The applicant filed the instant application on August 22, 2000. The Kamiyama reference is a U.S. patent application that was not filed until January 31, 2001 and that was not published until March 7, 2002. While the Kamiyama application does claim priority to an application that was filed on January 31, 2000, that application is a Japanese patent application. Thus, the reference

does not classify as prior art under and sub-section of 35 U.S.C. § 102, including sub-section 102(e), which only honors foreign priority dates based on "international application[s] filed under the treaty defined in section 351(a)." The treaty defined in section 351(a) is "the Patent Cooperation Treaty." Since the Kamiyama patent application was filed *after* the applicant's application, and claims priority to a Japanese patent application rather than a PCT application, it is not prior art under any sub-section of 35 U.S.C. § 102, including sub-section 102(e), and cannot be used as a reference against the pending claims.

As discussed above, claims 1-3 and 6-18 are believed to be in condition for allowance, which action is requested. Enclosed is a $110 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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